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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/016,159	01/30/98	LEE	J 07004-002002

HM12/0713  
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EXAMINER

HAMLID, F  
ART UNIT PAPER NUMBER

1647  
DATE MAILED:

07/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

file 477

**Office Action Summary**Application No.  
**09/016,159**Applicant(s)  
**JONG Y. LEE**Examiner  
**Fozia Hamud**Art Unit  
**1647**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on Apr 26, 2001

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 3-6 and 8-10 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 3-6 and 8-10 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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### **DETAILED ACTION**

1. The request filed on 1/24/01 in Paper No.21, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/016,159 is acceptable and a CPA has been established. An action on the CPA follows.

2. No amendment or response to the office action of 9/29/00 in Paper No:19 was filed.

Thus claims 3-6 and 8-10 are pending and under consideration.

3. All the previous objections and rejections made in the office action mailed on 26 September 2000 are maintained.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### **New matter:**

5. The amendment filed on 19 January 1999 is still objected to under 35 U.S.C. §132 for introducing new matter, because the EPO receptor sequence submitted in that amendment was not present in the application as originally filed, (see pages 2-3 of the office action mailed on 26 September 2000.

#### ***Claim Rejections - 35 U.S.C. § 112***

6a. Claims 3, 5 and 8-10, are rejected under 35 U.S.C. 112, first paragraph, because the for reasons of record as set forth in the office action of 26 September 2000, page 3. In summary, Applicants fail to demonstrate that they were in possession of **unglycosylated** EPO receptor polypeptides or antibodies specific for such polypeptides. This is a new matter rejection.

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6b. Claim 10 is rejected for reciting SEQ ID NO:5, because the recitation of this sequence is new matter.

***Claim Rejections - 35 U.S.C. § 102(b)***

7. The rejection of claims 3-5 and 8 made under 35 U.S.C. §102(b) as being anticipated by Harris et al. (JBC, 1992) is maintained for reasons of record as set forth in the office action of 26 September 2000, bottom of page 3.

***Claim Rejections - 35 U.S.C. § 103***

8. The rejection of claims 3-6 and 8-10 made under 35 U.S.C. §103 as being unpatentable over Harris et al. (JBC, 1992) in view of D'Andrea '808, is maintained for reasons of record as set forth in the office action of 26 September 2000, top of page 4.

***Conclusion***

9. No claim is allowed.

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the

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THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday, Wednesday-Thursday from 6:30AM to 4:00PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Fozia Hamud  
Patent Examiner  
Art Unit 1647  
July 11, 20001

CHRISTINE J. SAUD  
PRIMARY EXAMINER

*Christine J. Saud*